



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,644	09/08/2003	Rudolf J. Dams	57952US002	2822
32692	7590	09/24/2008		
3M INNOVATIVE PROPERTIES COMPANY				
PO BOX 33427				
ST. PAUL, MN 55133-3427				
EXAMINER				
SERGENT, RADON A				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/24/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

LegalDocketing@mmm.com

Office Action Summary

Application No.

10/657,644

Applicant(s)

DAMS ET AL.

Examiner

Rabon Sergeant

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11, 13-16 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-11, 13-16, 22-25, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 5, 2008 has been entered.
2. It is noted that applicants' amendments to the specification and the claims fail to comply with the provisions of 37 CFR 1.121. Firstly, it is noted that the amendment to page 34 of the specification is improper, because the WIPO number has been improperly changed to WO 02/30484. This change has been made without the required underlining and strikethrough. Also, it is noted that the number does not agree with that set forth within the amended table on pages 34 and 35. Secondly, claims 8 and 9 have been identified as Previously Presented; however, deleted subject matter has been set forth within each claim. Thirdly, new claims 33 and 34 are improper, because subject matter is improperly set forth with underlining.
3. The disclosure is objected to because of the following informalities: As aforementioned within paragraph 2, the WIPO number is inconsistent between the disclosure on page 34 and the amended table.

Appropriate correction is required.
4. Applicant's traversal of the withdrawing of claims 26 to 32 as being drawn to a non-elected invention is acknowledged. The traversal is on the ground(s) that the search of the claimed subject matter would not be unduly burdensome for the examiner. This is not found persuasive because the subject matter of the argued claims is distinct from the subject matter of the previously examined claims, in view of the use of polyfunctional isocyanate reactants.

Accordingly, despite applicants' argument, a distinctly different search is required for claims 26 to 32, and applicants have not established that such a distinctly different search would not be unduly burdensome.

The requirement is still deemed proper and is therefore made FINAL.

5. The amendment filed August 5, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendments to the specification indicating that Example 15, as opposed to Example 50, of WO 02/30484 (or WO 02/3848) is the comparative example. Applicants have provided no explanation as to how the amendments are supported by the original disclosure. The only previous discussion of Example 15 stemmed from the examiner's discussion of Example 15 in the prior Office action in response to applicants' arguments concerning unexpected results; however, the Example 15 previously referred to was Example 15 of applicants' specification, not Example 15 of the prior art.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. Claims 3-11, 13-16, 22-25, 33, and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Firstly, the examiner has reviewed the specification and has not found support for the R¹ and R² species, "dihydroxyalkyl", set forth within claims 24 and 25 (and nonelected claims 26

and 27). Despite applicants' response, the species at issue is not recited within lines 13 to 17 of page 4 and the specification does not contain page 26 or a Glossary (on page 26). The only page 26 present contains claims.

Secondly, with respect to claim 5, support has not been provided for the claimed weight percent range of component (b) or the condition that the recited amounts are based on the total weight of the composition. It does not necessarily follow that the amount of solvent equals the total weight minus the weight of component (a), in the absence of disclosure to that effect.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 3-11, 13-16, 22-25, 33, and 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4, 6-10, and 18-24 of copending Application No. 10/729,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed subject matter is encompassed by the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5-11, 13-16, 22-25, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. ('272).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Moore et al. disclose fluorinated polyether silane compositions and their application to substrates, such as ceramics and glass. Moore et al. further disclose that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds that correspond to applicants' claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants' claimed silane compound. The reference further teaches that solvents, including fluorinated solvents, are utilized within the

compositions. See abstract; columns 3-5; column 11, lines 13+; and Example B within column 13.

11. Applicants' statement that the patent to Moore et al. is derived from the inventor of the instant application and is not the invention by "another" fails to overcome the rejection. It has already been established that the reference and the instant application share a common inventor; however, the fact remains that the inventive entities of the patent and instant application are different. Accordingly, despite applicants' response, the different inventive entity of the patent constitutes "another".

12. Claims 5-11, 13-16, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/30848.

The reference discloses fluorinated polyether silane compositions and their application to such substrates as ceramics and glass. The reference further discloses that the fluorinated polyether silanes may be produced by reacting isocyanate reactive perfluorinated compounds that correspond to applicants' claimed fluorinated polyether compound with isocyanate functional silane compounds that correspond to applicants' claimed silane compound. The reference further teaches that fluorinated solvents may be utilized within the compositions. See pages 4-9 and 11, and especially examples B and D within page 12.

13. Applicants have argued that T and T' represent a $-\text{CO}_2\text{R}^3$ group or a $-\text{C}(\text{O})\text{N}(\text{R}^1)(\text{R}^2)$ group, whereas WO 02/30848 recites compositions that contain urethane linkages. In response, WO 02/30848 clearly discloses page 5, line 14 and page 6, line 5 that the preferred linking group is an amide group, and the position is taken that the same compound would result from the reaction of an isocyanate functional silane with a carboxyl functional fluorinated polyether, since

isocyanate groups react with carboxyl groups to yield amide groups. Accordingly, these preferred teachings are considered to satisfy applicants' claim limitations. Furthermore, arguments pertaining to superior or unexpected results are not germane to the issue of anticipation. However, even if such showings were germane, applicants' argued showings would be insufficient in view of the disclosed preference for amide groups, since the comparative urethane containing compounds would not be representative of the closest relied on teachings.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As aforementioned within paragraphs 10 and 12, the primary references disclose solvent containing fluorinated polyether silane compositions which are considered to meet those claimed; however, the primary references are silent with respect to the incorporation of surfactants or fluorosurfactants into the composition. However, the use of surfactants, such as fluorosurfactants, within fluorinated coating compositions was well known at the time of invention. This position is supported by the teachings of Brown at column 19, lines 5-7, Scicchitano et al. at paragraph [0081], and WO 01/34670 at page 9, lines 16+. Since it has been held that it is *prima facie* obvious to use a known compound for its art recognized purpose, the position is taken that it would have been obvious to utilize the claimed fluorosurfactants in their art recognized capacity as additives for fluorinated coating compositions, so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

15. Applicants' arguments with respect to Moore et al. have been addressed within paragraph 10. Furthermore, it is noted that while applicants have referred to a declaration under 37 CFR

1.132, no declaration has been received by the Office. Furthermore, regarding WO 02/30848, applicants' arguments with respect to the linkages of component (a) have been addressed within paragraph 13. Applicants argued results are deficient, because the relied upon showings must be commensurate in scope with the claims; however, the rejected claims require the use of a surfactant, and it appears that only applicants' Example 15 utilizes a surfactant. However, even Example 15 is not commensurate in scope, because it encompasses additional components, such as water and acetic acid, that are not required by the claims. In further support of this position, the scope of the claims, as well as the prior art, encompasses a much greater scope of reactants than is represented by Example 15. Lastly, it is by no means clear that the relied upon example of WO 02/30848 is representative of the most relevant teachings of the reference, because the most relevant teachings are considered to be those concerned with the production of amide containing compositions in view of the aforementioned disclosure within pages 5 and 6 of the reference. From applicants' discussion of Example 15, it appears that applicants have confused Example 15 of the prior art with the examiner's discussion of applicants' own Example 15. Clarification is required.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670, and further in view of WO 01/30873.

As aforementioned within paragraphs 10 and 12, the primary references disclose solvent containing fluorinated polyether silane compositions which are considered to meet those claimed; however, the primary references are silent with respect to the incorporation of the fluorosurfactant of claim 3 into the composition. However, the use of surfactants, such as

Art Unit: 1796

fluorosurfactants, within fluorinated coating compositions was well known at the time of invention. This position is supported by the teachings of Brown at column 19, lines 5-7, Scicchitano et al. at paragraph [0081], and WO 01/34670 at page 9, lines 16+. Furthermore, the claimed fluorosurfactant of claim 3 was known at the time of invention as evidenced by the teachings of WO 01/30873 (see pages 7 and 11). Since it has been held that it is *prima facie* obvious to use a known compound for its art recognized purpose, the position is taken that it would have been obvious to utilize the fluorosurfactant of WO 01/30873 as the fluorosurfactant disclosed within Brown, Scicchitano et al., or WO 01/34670 in its art recognized capacity as additives for fluorinated coating compositions, so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
September 19, 2008